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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/597,655	08/02/2006	Oliver A. Caillault	87338AJA	4454

1333 7590 01/08/2009
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EXAMINER	
CLARK, GREGORY D	

ART UNIT	PAPER NUMBER
1794	

MAIL DATE	DELIVERY MODE
01/08/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

DETAILED ACTION

Election/Restrictions

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-9, drawn to inkjet recording element.
Group II, claim 10, drawn to method of modifying a surface.

The inventions listed as Groups I and II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: The special technical feature does not provide a contribution over the prior art because the special technical feature is disclosed in Kitamura (2001/0016249). Kitamura teaches an inkjet recording element with a support and an in receiving containing allophnae like aluminoslilcate particles that can be pretreated with acid.

During a telephone conversation with Art Kluegel on 12/19/2008 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-9. Affirmation of this election must be made by applicant in replying to this Office action.

Claim 10 is withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed to a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP

§ 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder**. Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

Claim Rejections - 35 USC § 102

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-4, 8 and 9 are rejected under 35 U.S.C. 102(e) as being unpatentable by Kapusniak (2005/0158483).

Regarding Claims 1-4, Kapusniak discloses an inkjet recording element containing a support having thereon a subbing layer (ink receiving layer) containing particles of an aluminosilicate (abstract). Kapusniak further discloses that the aluminosilicate can be natural allophone (paragraph 34), synthetic allophone like (paragraph 41), and amorphous and acidic (paragraph 41).

Regarding Claims 8 and 9, Kapusniak discloses an ink jet recording element containing polyvinyl alcohol (hydrosoluble binder) or gelatin (paragraph 26).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kapusniak (2005/0158483).

Regarding Claim 6, Kapusniak discloses that the aluminosilicate makes up 1 to 20% of the particles in the subbing layer (receiving layer) (paragraph 34). Kapusniak does not teach an ink receiving layer containing between 5 and 95% aluminosilicate particles.

Kapusniak does not teach the exact same range as recited in the instant claim, however the ranges do touch and there is significant overlap. Such particles are known to by effective at absorbing ink and a person on ordinary skill in the art would adjust the particle level to optimize the absorption capacity of the receiving layer.

One of ordinary skill in the art at the time the invention was made would have considered the invention to have been obvious because the compositional proportions taught by Kapusniak overlap the instantly claimed proportions and therefore are considered to establish a prima facie case of obviousness. It would have been obvious to one of ordinary skill in the art to select any portion of the disclosed ranges including the instantly claimed ranges from the ranges disclosed in the prior art reference, particularly in view of the fact that;

> "The normal desire of scientists or artisans to improve upon what is already generally known provides the motivation to determine where in a disclosed set of percentage ranges is the optimum combination of percentages", In re Peterson 65 USPQ2d 1379 (CAFC 2003).

Regarding Claim 7, Kapusniak discloses that the aluminosilicate can be natural allophone (paragraph 34), synthetic allophone like (paragraph 41), and amorphous and

acidic (paragraph 41). Kapusniak does not teach a pH of 1.5 and 5.5 for the receiving layer.

Kapusniak discloses the claimed invention except for giving the pH of the receiving layer. It would have been obvious to one having ordinary skill in the art at the time the invention was made to adjust the pH by treatment with the appropriate acid, since it has been held that the provision of adjustability, where needed, involves only routine skill in the art. *In re Stevens*, 101 USPQ 284 (CCPA 1954).

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kapusniak (2005/0158483) in view of Doronin (RU 2205685).

Regarding Claim 5, Kapusniak discloses that the aluminosilicate can amorphous and acidic (paragraph 41). Kapusniak doses not disclose the means by which the aluminosilicate in made acidic. Doronin discloses a method for preparing aluminosilicate involving treatment with nitric acid (abstract)

At the time of the invention, it would have been obvious to one of ordinary skill in the art, having the teaching of Kapusniak and Doronin before him or her to modify aluminosilicate preparation method of Kapusniak to include the preparation of aluminosilicate involving nitric acid of Doronin because Kapusniak uses an amorphous aluminoslilcate and the preparation method taught by Doronin could easily incorporated.

The suggestion/motivation for doing so would have been that the preparation method taught by Doronin gives porous aluminosilicate composites suitable as adsorbents with and increased strength of material (abstract).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to GREGORY CLARK whose telephone number is (571)270-7087. The examiner can normally be reached on M-Th 7:00 AM to 5 PM Alternating Fri 7:30 AM to 4 PM and Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Larry Tarazano can be reached on (571) 272-1515. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/D. Lawrence Tarazano/
Supervisory Patent Examiner, Art Unit 1794

GDC